

REMARKS

I. Status of Claims

By this Amendment, claims 1, 19, 35, 36, and 38 have been amended. No new matter has been added. Claims 1-53 are present in this application and pending on the merits.

II. Claim Amendments

Applicant has amended independent claims 1, 19, 35, 36, and 38 to recite, *inter alia*, “a first pigment component comprising particulate GCC having a psd steepness factor ranging from about 30 to less than about 36,” which is fully supported by at least page 4, lines 11-12, of the originally-filed application. Applicant respectfully submits that the subject matter recited by these amendments simply claims less than the full scope of the range disclosed in the present application—a legitimate procedure for inventors entitled to decide the bounds of protection they seek. *See, e.g., In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977); *see also* M.P.E.P. § 2163.05 (III) (citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (C.C.P.A. 1976) (finding that the claimed range “between 35% and 60%” was fully described by the specification’s recitation of “25% - 60%.”)). Accordingly, no new matter has been added by these amendments, and Applicant respectfully requests that they be entered without objection.

III. Rejections under 35 U.S.C. § 103(a)

The Office has rejected claims 1, 5-17, 19-43, and 47-53 under 35 U.S.C. § 103(a) as allegedly being obvious based on WO 00/66510 to Lyons et al. (“Lyons”), claims 2-4 and 18 under 35 U.S.C. § 103(a) as allegedly being obvious based on Lyons

in view of U.S. Patent No. 5,879,442 to Nishiguchi et al. ("Nishiguchi"), and claims 44-46 under 35 U.S.C. § 103(a) as allegedly being obvious based on Lyons in view of U.S. Patent Application Publication No. US 2005/0126730 to Lorusso ("Lorusso") (*id.*). *Final Office Action* at 2.

The Office asserts that Lyons discloses GCC with a steepness "larger than about 38" because the term "about" permits some tolerance, and close ranges have been held to establish *prima facie* obviousness. *Id.* at 3. Furthermore, while acknowledging Applicant's presentation of Lyons teaching away from GCC having a steepness of about 30 or about 36, the Office nonetheless asserts that "the prior art does not disclose that the steepness factor between the range of about 36 to about 38 is unacceptable." *Id.*

As outlined above, independent claims 1, 19, 35, 36, and 38 have been amended herein to recite, *inter alia*, a first pigment component comprising particulate GCC having a psd steepness factor ranging "from about 30 to less than about 36." As explained in Applicant's previous responses, not only does Lyons fail to teach or suggest a first pigment component comprising particulate GCC having a psd steepness factor in that range, but Lyons also teaches away from the use of such a ground calcium carbonate. Where Lyons discloses the possible use of a ground calcium carbonate, Lyons teaches that the carbonate should have a "steep" particle size distribution (*see, e.g.*, Abstract; page 5, lines 3-11; page 6, lines 15-21; page 7, lines 19-21; page 13, lines 3-9; page 18, line 29 to page 19, line 2), that the steepness must be "greater than about 38" (*see, e.g.*, page 8, lines 12-17; claim 1), and "preferably greater than about 40" (*see,*

e.g., page 8, lines 12-17; claim 11). Moreover, as previously explained, Lyons expressly discloses that examples comprising ground calcium carbonates with steepnesses within the range from about 30 to less than about 36 (GCC B = "about 30" and GCC C = "about 36") are inferior and/or unacceptable, as compared to compositions comprising ground calcium carbonates having steepness "greater than about 38," such as those disclosed in Lyons. See Examples 1 and 5-8.

Taken as a whole, Lyons teaches that ground calcium carbonates having the particle size distribution and steepness factor recited by the pending independent claims ("ranging from about 30 to less than about 36") would not have the same properties as those taught by Lyons ("greater than about 38"), and would be inferior and/or unacceptable. For at least these reasons, a *prima facie* case of obviousness has not been established.

Nothing in Nishiguchi or Lorusso remedies these deficiencies of Lyons. In particular, like Lyons, neither Nishiguchi nor Lorusso teaches or suggests at least a composition comprising GCC having a psd steepness factor ranging from about 30 to less than about 36 in combination with a PCC having a psd steepness factor ranging from about 55 to about 75, as claimed. Nor do they recognize the surprising synergistic effect achieved by the subject matter recited in the claims.

For at least the above-outlined reasons, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejections of claims 1, 5-17, 19-43, and 47-53 based on Lyons, claims 2-4 and 18 based on Lyons in view of Nishiguchi, and claims 44-46 based on Lyons and Lorusso.

IV. Conclusion

For at least the above-outlined reasons, Applicant respectfully requests entry of the amendments included in this Response, reconsideration of this application, withdrawal of the claim rejections, and allowance of all of pending claims 1-53.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether any of those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6430.

Please grant any extensions of time required to enter this Response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 10, 2009

By: /Jeffrey A. Freeman/
Jeffrey A. Freeman
Reg. No. 58,275